

REMARKS

Applicant has carefully reviewed the Final Office Action of November 9, 2004, and offers the following remarks in response thereto. Applicant appreciates the telephonic interview with Examiner Gold on December 16, 2004 when several of the issues addressed below were discussed. Where appropriate, the interview is referenced. These remarks are intended to serve as the Interview Summary.

Applicant initially amends the claims to delete reference characters such as "a", "b", and "c". No new matter is added by these amendments and the scope of the claims has not changed.

Claims 9, 11, 13, 16, 27, 29, 32-34, 36-39 and 41-43 are amended to make the claim terminology consistent throughout and specifically to make sure that the claim elements have proper antecedent basis. Again, the scope of the claims is not changed, but the terminology is made consistent.

When Applicant called Examiner Gold to discuss scheduling the telephonic interview, Applicant queried whether the Office Action was properly final. The Examiner indicated that he would investigate this issue. During the subsequent telephonic interview, when Applicant raised this question again, the Examiner indicated that he felt the finality was premature, and offered to withdraw the finality and resend the Office Action. Applicant responded by requesting the opportunity to file a response as if the Office Action of November 9, 2004 was not final, so that the next Office Action could advance prosecution rather than merely reset the time period for reply.

While this issue was discussed during the telephonic interview, for the sake of written record Applicant herein provides Applicant's rationale for why the finality of the Office Action was premature. In the Office Action of November 9, 2004, the Patent Office asserts that Applicant's amendment necessitated the new grounds of rejection (see Office Action, paragraph 5 on page 11). Applicant did not amend the claims for which a new basis of rejection was made. Specifically, claims 1-46 remain in their original form, yet the rejection thereof has changed from a § 102 rejection under Denecheau et al. to a § 103 rejection under Denecheau et al. in view of Hericourt. Thus, the new basis of rejection was not necessitated by Applicant, and it is improper to make the rejection final. MPEP § 706.07(a). Applicant requests withdrawal of the finality of the rejection, and a new Office Action that responds substantively to the arguments presented below.

Claims 1-47 and 50 were rejected under 35 U.S.C. § 103 as being unpatentable over Denecheau et al. (hereinafter "Denecheau") in view of Hericourt. Applicant respectfully traverses. For the Patent Office to advance a combination of references to support an obviousness rejection, the Patent Office must do two things. First, the Patent Office must articulate a motivation to combine the references, and second, the Patent Office must support the motivation with actual evidence. *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). Even if the references are properly combinable, to establish *prima facie* obviousness, the Patent Office must show where each and every element of the claim is located in the combination of references. MPEP § 2143.03.

Applicant presented *Dembiczak*'s instructions to the Examiner during the telephonic interview, while noting that the Patent Office has historically been unreceptive to *Dembiczak* arguments. Specifically, the Patent Office typically responds to a *Dembiczak* citation with the same boiler plate paragraph that reads:

the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347 (Fed. Cir. 1992),

To further advance the prosecution of this application, Applicant preemptively addresses this boiler plate language. Applicant initially notes that *Dembiczak* is a more recent decision and represents new instructions for the Patent Office in its obviousness analysis. Applicant further notes that *Dembiczak* specifically acknowledged *In re Fine* and, while affirming the range of sources available to support the motivation to combine, the Federal Circuit instructed that the range of sources available to provide a suggestion to combine the references does not diminish the need for actual evidence. *In re Dembiczak* at 999. Thus, the Patent Office's boiler plate response to the instructions in *Dembiczak* ignores the real instruction of *Dembiczak* - namely that the Patent Office must provide actual evidence to support the motivation to combine, and cannot rely on a mere assertion that it would be obvious to combine references for some reason.

As Applicant argued in the telephonic interview, the motivation to combine the references set forth in the Office Action is insufficient to satisfy the requirements of *Dembiczak*. Specifically, in the Office Action, the Patent Office states that it would have been obvious "to

modify Denecheau in view of Hericourt to use routing on an application level. One would be motivated to do so because it allows for the routing of traffic on the application level." As noted in the telephonic interview, there is no evidence to support this asserted motivation. The Patent Office indicated that upon further review, the motivation set forth in the Office Action was not well articulated, and that the Patent Office would revisit this issue upon receipt of Applicant's response. Applicant requests that the Patent Office do so in light of the remarks presented herein.

During the telephonic interview, the Patent Office raised a point which Applicant would like to address. Specifically, as understood by Applicant's representative, the Patent Office argued that the Hericourt was concerned with traffic routing, and was directed to application level processing. The Patent Office opined that Denecheau was also very much concerned with traffic routing, and therefore the references seemed very analogous.

Merely because references are analogous and/or capable of being combined, there is not necessarily a motivation to combine the references. MPEP § 2143.01. There still must be actual evidence providing a teaching or suggestion to combine the references. In the absence of actual evidence to support a motivation to combine, the combination is improper, and the rejection is improper. Since the rejection is improper, the Patent Office has not established *prima facie* obviousness. Since the Patent Office has not established obviousness, the claims are allowable.

Applicant requests withdrawal of the § 103 rejection of claims 1-47 and 50 at this time. A few claims deserve special mention. For example, claim 2 recites "the selecting step further comprises determining the at least one routing node from the plurality of routing nodes to provide the application level support in a manner to balance processing load among the plurality of routing nodes." Applicant discussed this claim during the telephonic interview, stating that this element was not shown by the combination. That is, assuming, *arguendo*, that the combination of Denecheau and Hericourt is proper, the combination does not result in the claimed invention. When combined, Denecheau and Hericourt teach a system that does "next hop" load balancing (as taught by Denecheau) and application shortest distance routing (as taught by Hericourt), but does not teach load balancing at the application layer processing level, as recited in the claim. The Patent Office opines that the element is taught at Denecheau column 6, line 66-column 7, line 20. However, this is load balancing at the network level, not at the application level. Likewise, Hericourt, column 7, lines 32-40 teaches that the routing access

rules will require a source device in France to access a Proxy Server in France rather than Japan to minimize path requirements and consequently minimize network resources utilization. As such, there is no teaching or suggestion of load balancing at the application level. Thus, in combination, the references do not teach or suggest load balancing at the application level, as recited in the claims.

Applicant discussed this difference with the Examiner during the telephonic interview, and the Examiner's initial response was that "load balancing" was a very broad term. However, the claim does not recite just load balancing. The claim recites "to provide the application level support in a manner to balance processing load among the plurality of routing nodes." To this extent, Applicant respectfully maintains that the claim has an element which is not shown in the combination.

Claim 14 recites "determining how to distribute the processing. . .based on the resources necessary for application level support." As noted above, Hericourt does not determine resources necessary for application level support, but rather teaches that application processing resources are dedicated based on shortest distance. Thus, this element is not taught by the combination of references, and the claim is not rendered obvious.

Claims 17 and 44 are similar to claim 14, and are not obvious for at least the same reasons.

Claims 20 and 32 are similar to claim 2, and are not obvious for at least the same reasons.

Claim 21 recites "determining the at least one routing node from the plurality of routing nodes based on available processing capacity of the at least one routing node" Even if the Patent Office is correct, and "load balancing" may be broadly interpreted, claim 21's recitation of the processing capacity indicates what sort of load balancing is contemplated and thus, a broad shortest distance load balancing system (if such a thing could be considered load balancing) is not the same as the recited element. To this extent, claim 21 is non-obvious. Claims 22-25, 33, 34, and 36 are similar in this regard.

Claims 48 and 49 were rejected under 35 U.S.C. § 103 as being unpatentable over Denecheau in view of Hericourt, and further in view of Chiu et al. (hereinafter "Chiu"). Applicant respectfully traverses. The standards for combining references are set forth above.

Applicant initially notes that the Patent Office relies on the same combination of Denecheau and Hericourt addressed above. Since this combination is not proper, the tripart

combination is not proper. Applicant further traverses the combination of Chiu. Specifically, the Patent Office opines that the motivation to combine Chiu would "allow for more ways to route the traffic which would provide more efficient routing overall." This statement is not supported with the requisite actual evidence, and thus this combination is improper. Since each of the combinations is improper, the rejection is improper. Applicant requests withdrawal of the § 103 rejection of claims 48 and 49 at this time.

Applicant requests reconsideration of the rejections in light of the above remarks.
Applicant earnestly solicits claim allowance at the Examiner's earliest convenience.


Respectfully submitted,

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